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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/568,252 | 08/02/2006 | Richard F. Labaudiniere | 27092017008 | 9703 |

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| EXAMINER |
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JAVANMARD, SAHAR

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| ART UNIT | PAPER NUMBER |
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1627

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06/08/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/568,252 | Applicant(s) LABAUDINIERE ET AL. | |
| | Examiner SAHAR JAVANMARD | Art Unit 1627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9,11,12,14,15,18-20,23,24,26-32,34-38 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-4,6-9,11,12,14,15,18-20,26,30-32,34-38 and 40-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23,24 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/21/06; 2/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

This Office Action is in response to Applicant's Restriction Requirement remarks filed on March 26, 2010. Claim(s) 1-4, 6-9, 11, 12, 14, 15, 18-20, 23, 24, 26-32, 34-38, and 40-42 are pending. Claim(s) 1-4, 6-9, 11, 12, 14, 15, 18-20, 26, 30-32, 34-38, and 40-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant's election of Group III drawn to a compounds represented by structural formula I-a' and election of species of the compound of formula I-a', wherein R1-R3 are H and R4 is COOH without traverse of the restriction requirement in the reply is acknowledged. The requirement is deemed proper and is therefore made FINAL. Claim(s) 23, 24, and 27-29 are examined herein insofar as they read on the elected invention and species.

Objections

Claims drawn to non-elected inventions have incorrect claim status identifiers. Appropriate action is required.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 23, 24, and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Suto (US Pub. No. 2004/0180889).

Suto teaches the compound of formula I-a', wherein R1, R3 and R4 are H and R2 is COOH (page 64, column 2, 4th compound), meeting the limitations of the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 23, 24, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerlach (US Patent No. 6,699,877B2) of record.

Gerlach teaches 1,2,3,4-tetrahydroquinoline-2-carboxylic acid derivatives of formula I, wherein R1 and R2 together form an unsaturated cyclopentane ring; R3 is H; R4 is H; R5-R8 are R5, R6, R7 and R8, independently of one another, are H, F, Cl, Br, I, CN, NO₂; respectively branched or unbranched, singly or multiply substituted or unsubstituted C1-C10 alkyl, C2-C10 alkenyl or C2-C10 alkynyl; OR₁₄, OC(O)R₁₄, OC(S)R₁₄, C(O)R₁₄, C(O)OR₁₄, C(S)R₁₄, C(S)OR₁₄, SR₁₄, S(O)R₁₄ or S(O₂)R₁₄, wherein R₁₄ is H; respectively branched or unbranched, singly or multiply substituted or unsubstituted C1-C10 alkyl, C2-C10 alkenyl or C2-C10 alkynyl; saturated or unsaturated, singly or multiply substituted or unsubstituted C3-C8 cycloalkyl, or a corresponding heterocycle, in which at least one carbon atom in the ring is replaced by S, O or N; respectively singly or multiply substituted or unsubstituted alkyl aryl or alkyl heteroaryl; respectively singly or multiply substituted or unsubstituted aryl or heteroaryl; NR₁₅R₁₆, NR₁₅C(O)R₁₆, C(NR₁₅)NR₁₆R₁₇, NR₁₅C(S)R₁₆, C(S)NR₁₅R₁₆ or C(S)NR₁₅NR₁₆R₁₇ or S(O₂)NR₁₅R₁₆, wherein R₁₅, R₁₆ and R₁₇, independently of one another, are H, O; respectively branched or unbranched, singly or multiply substituted or unsubstituted C1-C18 alkyl, C2-C18 alkenyl or C2-C18 alkynyl; saturated or unsaturated, singly or multiply substituted or unsubstituted C3-C8 cycloalkyl, or a

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corresponding heterocycle, in which at least one carbon atom in the ring is replaced by S, O or N, respectively singly or multiply substituted or unsubstituted alkyl aryl or alkyl heteroaryl; or respectively singly or multiply substituted or unsubstituted aryl or heteroaryl; or R15 and R16 or R16 and R17 together form a saturated or unsaturated, singly or multiply substituted or unsubstituted C3-C8 cycloalkyl, or a corresponding heterocycle in which at least one carbon atom in the ring is replaced by S, O or N; or R5 and R6, R6 and R7 or R7 and R8 together form CR₁₈CHCHCH or CHCR₁₈CHCH, wherein R₁₈ is H, F, Cl, Br, I, OH or respectively branched or unbranched, singly or multiply substituted or unsubstituted C1-C10 alkyl, C2-C10 alkenyl or C2-C10 alkynyl; provided that if R1 and R2 together form CHCHCH₂ or R3 is ()p-menthan-3-ol, and R7Cl, then R5, R6 and R8 are not simultaneously H, if R1 and R2 together form CHCHCH₂, R3 is CH₃, and R7 is H, Cl or OCH₃, then R5, R6 and R8 are not simultaneously H, if R1 and R2 together form CHCHCH₂, R3 is H, and if R7 is OCH₃ or C(O)NH₂, then R5, R6 and R8 are not simultaneously H, if R5R7CH₃, then R6 and R8 are not simultaneously H, if R5OCH₃, then R6, R7 and R8 are not simultaneously H, and if R1 and R2 together form or OCH₂CH₂ and R3 is C₂H₅ and if R7 is H, Cl, CH₃, OCH₃ or NO₂, then R5, R6 and R8 are not simultaneously H, and if R5NO₂; then R6, R7 and R8 are not simultaneously H (column 2-column 4; claim 1).

The specific combination of features claimed is disclosed within the broad generic ranges taught by the reference but such "picking and choosing" within several variables does not necessarily give rise to anticipation. *Corning Glass Works v. Sumitomo Elec.*, 868 F.2d 1251, 1262 (Fed. Circ. 1989). Where, as here, the reference

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does not provide any motivation to select this specific combination of variables, anticipation cannot be found.

That being said, however, it must be remembered that "[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious". *KSR v. Teleflex*, 127 S. Ct. 1727, 1740 (2007) (quoting *Sakraida v. A.G. Pro*, 425 U.S. 273, 282 (1976)). "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious", the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." (*Ida*). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR v. Teleflex*, 127 S. Ct. 1727, 1741 (2007). The Court emphasized that "[a] person of ordinary skill is... a person of ordinary creativity, not an automaton." *Id.* at 1742.

Consistent with this reasoning, it would have obvious to have selected various combinations of various substituents from within a prior art disclosure, to arrive at the compounds that are encompassed by the compounds of formula I-a'.

Therefore, based on reasons of record, the claims 23, 24, and 27-29 are deemed unpatentable over the cited art.

Conclusion

Claims 23, 24, and 27-29 are not allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahar Javanmard whose telephone number is (571) 270-3280. The examiner can normally be reached on 8 AM-5 PM MON-FRI (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/S. J./

Examiner, Art Unit 1627

/SREENI PADMANABHAN/

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Supervisory Patent Examiner, Art Unit 1627